

REMARKS**Summary of the Office Action**

In the Office Action, claims 1-2 and 5-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,431,196 to *Forrester, Jr., et al.*, (“*Forrester*”).

Claims 1, 3, 4, and 8-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,947,166 to *Doyle, et al.*, (“*Doyle*”).

Summary of the Response to the Office Action

Applicants propose canceling claim 7 without prejudice or disclaimer and amending claims 1, 5, 6, 8, and 10. Applicants propose adding claims 11 and 12. Accordingly, claims 1-6 and 8-12 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1-2 and 5-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Forrester*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Forrester* anticipates each and every feature of Applicants’ claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, newly amended independent claims 1, 5, and 6, respectively recite a “detecting means for detecting the reverse rotational number,” or “a pulse detecting circuit that detects the rotational number of the motor,” or “a rotational number sensor that detects the rotational number of the drive sheave.” At least these features are not disclosed or taught by *Forrester*.

Forrester discloses a rebar tying tool that is lightweight and safely and automatically installs wire ties. See *Forrester* at col. 2, lines 35-40. However, *Forrester* fails to teach or suggest at least the above features of claims 1, 5, and 6.

The Office Action states that the “predetermined rotational number . . . is not considered to distinguish over the predetermined time period [in *Forrester*] set for the motor reversing . . . since the motor operates at a constant RPM.” That is, the Office Action states that the predetermined time period set until the feed motor is reversed multiplied by the constant revolutions per minute equals the “predetermined rotational number” of the present invention. Contrary to this assertion, there is no evidence that *Forrester* discloses a “detecting means for detecting the reverse rotational number,” or “a pulse detecting circuit that detects the rotational number of the motor,” or “a rotational number sensor that detects the rotational number of the drive sheave,” as recited in independent claims 1, 5, and 6, respectively. Because *Forrester* does not disclose these features it cannot anticipate the invention recited in claims 1, 5, and 6.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Forrester* does not teach or suggest each feature of independent claims 1, 5, and 6.

Additionally, Applicants respectfully submit that dependent claim 2 is also allowable insofar as it recites the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Claims 1, 3, 4, and 8-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Doyle*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Doyle* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Specifically, newly amended independent claims 1, 8, and 10 respectively recite a "detecting means for detecting the reverse rotational number," or "a pulse detecting circuit that detects the rotational number of the motor," or "a rotational number sensor that detects the rotational number of the drive sheave." At least these features are not disclosed or taught by *Doyle*.

Doyle discloses a wire tying tool having a set of movable talons for channeling a loop of hard wire around a rebar joint or other objects to be tied with a wire knot at high speed. See the Abstract of *Doyle*. However, *Doyle* fails to teach or suggest at least the above features of claims 1, 8, and 10.

The Office Action states that "the motor continues operating in reverse until the guide jaws 400, 401 are fully opened which, due to the mechanical linkage of the drives, would include a predetermined rotational number." Contrary to this assertion, there is no evidence that *Doyle* discloses either a "detecting means for detecting the reverse rotational number," or "a pulse detecting circuit that detects the rotational number of the motor," or "a rotational number sensor that detects the rotational number of the drive sheave," as recited in independent claims 1, 5, and 6, respectively. Because *Doyle* does not disclose these features it cannot anticipate the invention recited in claims 1, 8, and 10.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Doyle* does not teach or suggest each feature of independent claims 1, 8, and 10.

Additionally, Applicants respectfully submit that dependent claims 3, 4, and 9 are also allowable insofar as they recite the patentable combinations of features recited in claims 1 and 8, as well as reciting additional features that further distinguish over the applied prior art.

New Claims

Applicants respectfully submit that new dependent claims 11 and 12 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art. Accordingly, Applicants respectfully request that claims 1-6 and 8-12 be passed on to allowance.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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